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09/891,271	06/27/2001	Hans-Uwe Baumann	037 / 49843	1615

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EXAMINER

VAN PELT, BRADLEY J

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 15

Application Number: 09/891,271
Filing Date: June 27, 2001
Appellant(s): BAUMANN ET AL.

Vincent J. Sunderdick
For Appellant

EXAMINER'S ANSWER

MAILED

JAN 27 2004

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This is in response to the appeal brief filed November 5, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-3 and 6-11 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

3,192,794 Counts 7-1965

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3 and 6-11 are rejected under 35 U.S.C. 102. This rejection is set forth in prior Office Action, Paper No. 8.

(11) Response to Argument

The appellants traverse the rejection of claims 1-3 and 6-11 alleging an erroneous interpretation of Counts. The appellants set forth a two-pronged argument: first contending that Counts does not disclose a “preassembled construction unit,” second contending that Counts does not disclose the construction unit is “optionally removable.” Both limitations are recited in independent claims 1, 6, and 9. The answer addresses both limitations. Claims 1 and 6 are drawn to the product and claim 9 is drawn a process of making the product.

Pre-assembled construction unit

Claim 1, drawn to a product, recites “the clutch pedal is swivellably held in an insert which *forms a preassembled* constructional unit.” In this limitation, the appellants are claiming a process at which the receiving device is made. If this claim was drawn to a process, in order to meet this limitation the insert and the clutch must be assembled or joined prior to full assembly of a non-indicated element, however, claim 1 is a product claim.

Although the product by process claim is permissible, the process in which the product is made cannot be given patentable weight in a product claim. In other words, the determination of patentability in a product-by-process claim is based on the product itself, even though the claim

may be limited and defined by the process. The product or article in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product or article was made by a different process. See *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985).

The appellants are describing a process at which the receiving device is assembled by indicating the construction unit is preassembled. Thus, the limitation "forms a preassembled construction unit" should not be given any patentable weight. For this reason, Counts need not disclose this limitation.

Claim 6, also drawn to a product, recites "a preassembled constructional unit fastenable between two projecting legs of the mounting plate and having a clutch pedal swivellably held in an insert." Again here the language "preassembled" indicates an order at which the product is assembled which is a process at which the pedal assembly is made and is given no patentable weight. Therefore, again the Counts reference need not disclose this limitation.

Regardless, the Counts reference does indeed disclose a preassembled constructional unit with the clutch pedal held in an insert. The examiner is allowed to give claims their broadest reasonable interpretation. The claim does not limit "preassembled" to the clutch and insert being joined before being inserted into the receiving device. Preassembled, thus, is a **relative** term, the claim does not indicate anything that the constructional unit precedes in assembly. In Counts, the clutch (14) and the insert (82) therefore are preassembled before adjusting the length of the rod (72) (see column 3, lines 20-25). Thus, Counts anticipates "a preassembled constructional unit."

Furthermore, it is noted that if the appellant added any language such as "the clutch and insert are preassembled before being placed into the receiving device or pedal assembly," the limitation would clearly be process language. Thus, it is clear that the appellants are relying on process language of no patentable weight in attempting to distinguish from Counts. However, the Counts reference alone anticipates a "preassembled constructional unit."

Appellants also argue that Counts does not add on a clutch pedal and that the clutch pedal is not part of any preassembled unit. It would be disingenuous to say that the clutch pedal is not added to the vehicle of Counts and is not preassembled. In the assembly of the vehicle one would cast, mill, and drill the pedal arm, and place a pad on the arm before placement in the vehicle. Therefore, the clutch pedal of Counts is part of a preassembled unit.

Optionally Removable

Again the appellants are relying on broad language to distinguish the instant invention from the Counts reference. In claims 1, 6, and 9 the appellants indicate that the constructional unit is constructed to be optionally removable. Although in the instant invention the constructional unit may questionably be removed with greater ease than the clutch pedal and insert of Counts, this alone does not determine the instant invention's patentability and is not a claimed limitation.

In Counts, the insert (82) is pinned to a clutch crank arm (92), which includes an attaching portion (94) held onto a support shaft (30) with a setscrew (96). To remove the construction unit one would unscrew the setscrew. Also the lower end (76) is threaded into bifurcated clevis (82) or insert. Therefore, one would simply unscrew the lower end (76) out of the insert (82) or unscrew the setscrew (96).


The Counts reference does not show how the clutch pedal's pivot portion is secured to the vehicle, however it is inherent that the clutch pedal is optionally removable with the insert (82). If something can be disassembled, it is constructed to be optionally removable. The examiner does not need to be exhaustive. It is inherent that the clutch must rotate relative to the vehicle, therefore, some sort of bearing holds the clutch pedal to the vehicle. By removing the bearing or by simply detaching the pedal from the bearing, and detaching the push rod (20), the clutch pedal will be removable. Little weight can be given to this limitation. Therefore, the Counts reference anticipates by inherency this limitation.

Since the Counts reference anticipates both a preassembled constructional unit and further the preassembled constructional unit is optionally removable, it is believed that the rejections should be sustained.

Respectfully submitted,

BJVP 
January 21, 2004

Conferees
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